

### REMARKS

This paper is responsive to a Final Office Action mailed November 9, 2005. Prior to this response claims 1 and 3-24 were pending. After amending claims 1, 3, 7-8, 12, 17, 22, and 24, canceling claims 10, 16, 19-20, and 23, and adding claims 25-26, claims 1, 3-9, 11-15, 17-18, 21-22, and 24-26 remain pending.

In Section 3 of the Office Action claims 1-21, 23, and 24 have been rejected under 35 U.S.C. 102(e) as anticipated by Joshi et al. ("646"; US 6,689,646). This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

'646 describes a process for using an inductively-coupled plasma source to oxidize a Si film (Abstract). Claims 1 and 24 of the instant application describe using a high density plasma source to form an M oxide, where M has an oxidation state in the range of 2 to 5. Claims 1 and 24 have been amended to further recite that Si is excluded as a possible member of the class of M elements.

The '646 reference does not describe any members of the class of M elements. Alternately stated, the '646 reference does not explicitly describe the claimed invention, since Si cannot be one of the M elements recited in claims 1 and 24. Since '646 does not describe every limitation of the claims 1 and 24, it cannot anticipate the claimed invention. Claims 3-9, 11-15, 17-18, 21-22, and 25, dependent from claim

1, also enjoy the same distinctions from the cited prior art, and the Applicant respectfully requests that the rejection be removed.

In Section 5 of the Office Action claim 22 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Joshi et al., in view of Han et al. ("Han"; US 2002/0100554). The Office Action states that Han describes ECR and ICP sources. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Han, in paragraph 41, describes ECR and ICP equipment that may be used for manufacturing a ceramic dielectric 20. With respect to the first *prima facie* requirement, the Han reference does not suggest that his ECR and ICP equipment can be used for the purpose of oxidation. Therefore, Han does not suggest that the '646 can be modified to oxidize any elements, other than the element (Si) already described in the '646 reference.

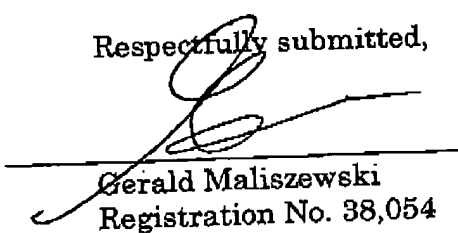
Considered from the perspective of the second *prima facie* requirement, an expert given the '646 and Han references as a foundation could not be reasonably expected to derive the invention of claim 1, since the combined references only describe the oxidation of Si.

With respect to the *third prima facie* requirement, the combination of the '646 and Han references does not explicitly describe every limitation of claim 1. As mentioned above, the '646 reference only describes the oxidation of Si, and Han does not describe any kind of oxidation process. The combination of references does not describe the oxidation of M, where M is an element with an oxidation state in the range of 2 to 5, excluding Si. Therefore, the combination of references does not explicitly describe every limitation of claim 1. Neither does the combination of references suggest a modification that would make the limitations of claim 1 obvious. Claim 22, dependent from claim 1, enjoys the same distinctions from the cited prior art, and the Applicant respectfully requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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